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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,554	03/29/2001	Kazutoyo Maehiro	6514-7	4973

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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application No.
09/820,554

Applicant(s)
Maehiro

Examiner
T. Chen

Art Unit
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 20, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other: _____

Art Unit: 2171

DETAILED ACTION

1. Claims 1 - 31 are presented for examination.
2. Acknowledgment is made of the claim for foreign priority under 35 U.S.C. § (a)-(d) or (f). All of the certified copies of the priority documents have been received and the priority claim is accepted.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation are requested in correcting any errors of which applicants may become aware in the specification. Also, It is noted that the present specification does not contain line numbers. For ease of reference by both Examiner and Applicant all future correspondence should include the recommended line numbering.

Claim Objections

4. Claim 31, is objected to because of the following informalities: the claimed statement -- "A computer program for bring a server into operation..." is grammatically improper, since it lacks of the supporting medium to bring a server into operation. Appropriate correction is required.

Art Unit: 2171

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5, 8, 11-13, 20, 23, 26 and 30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. As to claims 5, 8, 11-13, 20, 23, 26 and 30, the cited phrase “can be”, or “capable of” render the claimed features indistinct. Since these terms lead to the argument of anything actually occurs or results.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Application/Control Number: 09/820,554

Art Unit: 2171

9. Claims 1-31, are rejected under 35 U.S.C. 102(b) as being anticipated by MacNaughton et al. (U.S. Patent No. 5,769,393).

10. As to claims 1, 14-16 and 29-31, MacNaughton et al. (hereinafter referred as MacNaughton) discloses a computer system [e.g., see Abstract, Fig. 1] with apparatus, methods and computer program products as claimed by applicant, to perform the following processing, comprising:

a) a membership information retrieval server [e.g., see the Community Server (18), Fig. 1] accepts requests from a group of user terminals [e.g., see the user's terminal with Web browser (10), Fig. 1] via the Internet communication protocols [e.g., TCP/IP (16, 34), or HTTP or FTP or IRC, etc; col. 6, lines 35-37] to perform the following functions, comprising:

- * storing the membership information from a group of users to a storage device [e.g., see col. 8, lines 24-33; the Membership Database (44), Fig. 1B];

- * extracting selected membership information from the storage device in respond to the request [e.g., see the Who's Online service provided by the community server; col. 7, lines 5-6] from the system user [col. 1, lines 54-61; col. 8, lines 10-23];

- * displaying the membership information sent from the server on display of the user terminals [col.2, lines 19-23];

- * communicating to one or more members in the created temporary user list via messages [col. 16, lines 15 - 48].

Art Unit: 2171

11. As to claims 2-13 and 17-28, MacNaughton further discloses that the system having the features as claimed by applicant, including:

a) a determination system [e.g., 148, Fig. 4] that determines whether each of the group of the user terminals is current online [e.g., see 150, Fig. 4], wherein the communication server [e.g., 140, Fig. 4] imports the determination results into the membership information and then sends the membership information to the user terminal [col. 8, lines 43-65; Fig. 4; col. 16, lines 15 - 48];

b) the membership information includes user name, text , etc, which can be updated whenever necessary from the user terminal online [col. 8, lines 29-39].

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: MacNaughton et al. (U.S. Patent No. 6,020,884 and 6,433,795) which disclosed a computer system manages online service community with a foreign service; Ferguson et al. (U.S. Patent No. 5,819,092) which disclosed online service development tool with fee setting capabilities .

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen, whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

Application/Control Number: 09/820,554

Art Unit: 2171

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are:

(703) 746-7238 (After Final Communication);

(703) 746-7239 (Official Communications); and

(703) 746-7240 (For Status Inquiries, Draft Communication).

15. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

June 10, 2003



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100